

Application No. 10/719,369
Amendment dated February 14, 2008
Reply to Office action of August 22, 2007

REMARKS / ARGUMENTS

Summary of Claims Pending

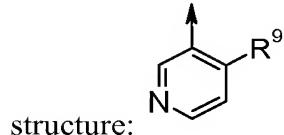
Claims 1-31 were pending. Claims 1-16, 22, 24, 27, 29 and 31 have been canceled by amendment herein. Thus, claims 17-21, 23 and 25, 26, 28 and 30 are now pending.

The claims have been amended so as to conform to the previous election of the invention of group IIA.

Miscellaneous Amendments

Definitions of R^{N1} and R^{N2} have been added to claim 17. These definitions are found in the specification at page 35 lines 12-17 and so the amendment does not introduce new matter.

In claim 25, the definition of Ar² has been amended by the deletion of the following



This has been done because it has no antecedent basis in claim 17, from which claim 25 depends.

Double Patenting Rejections

The pending claims stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of co-pending Application No. 11137831 (filed May 24, 2005).

According to MPEP § 804, “If a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.”

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It should be noted that the present application was filed is the earlier filed of the two pending applications. It is further urged that upon entry of the current claim amendments and consideration of these Remarks, the provisional obviousness-type double patenting rejection will be the only rejection remaining in this (the earlier filed) application, and that this application should be permitted to issue as a patent without a terminal disclaimer.

Claim Rejections Under 35 U.S.C. 103

The pending claims stand rejected under 35 USC 103(a) as being unpatentable over Girardet et al. (US 2006/0135556).

As the action notes, Girardet et al. teach compounds useful as reverse transcriptase inhibitors of HIV, with the structure HET-L-C(Y)NR1R2, wherein HET is a 5 or 6 membered heterocyclic ring. Triazole derivatives are disclosed as examples, but compounds wherein HET is a tetrazole are not expressly taught.

Thus it appears to be the position of the Office that the difference between the prior art and the claimed invention is that the prior art provides compounds wherein HET is a triazole whereas the claims are directed to analogous compounds wherein the corresponding group is a tetrazole. It further appears to be the position of the Office that it would have been obvious to one of skill in the art to replace the triazole of Girardet et al. with a tetrazole, to yield compounds that would fall within the scope of the instant claims.

For the reasons that follow, Applicant does not agree with that it would have been obvious to one of skill in the art to replace the triazole of Girardet et al. with a tetrazole, to yield compounds that would fall within the scope of the instant claims.

In the previous action (mailed February 8, 2007) the Office made a restriction requirement wherein compounds wherein Ar1 is a tetrazole were said to constitute one invention (Sub-Group A) and compounds wherein Ar1 is 1,2,4-triazole were said to constitute another invention (Sub-group B). In making this restriction requirement the Office stated, “The

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above-delineated inventions are independent and patentably distinct each from the other.”
(Emphasis added.)

In response to the restriction requirement, Applicant elected to prosecute claims directed to the invention of Group IIA (claims 17-30, drawn to compounds in which Ar1 is a tetrazole). The claims have now been amended so as to be limited to the elected subject matter.

In making the restriction requirement, the Office has taken the position that the elected subject matter (compounds in which Ar1 is a tetrazole) is patentably distinct from the non-elected subject matter (compounds wherein Ar1 is triazole). This position is inconsistent with and cannot be reconciled with the position now taken by the Office that it would be obvious to modify the triazoles of the cited reference to yield tetrazoles falling within the scope of the claimed invention. Triazoles cannot be patentably distinct from tetrazoles and yet render the latter obvious.

For the above reasons, the rejection under Section 103, based upon Girardet et al. (US 2006/0135556), should be withdrawn.

However, the Examiner’s attention is directed to WO 2004/030611 (equivalent to EP1545483), which is in the same patent family as Girardet et al. (US 2006/0135556). While Giradet does not expressly disclose any tetrazoles, WO 2004/030611 does. Attention is more specifically directed to Compound ID 10 on page 57 of WO 2004/030611, which is a tetrazole. Compound ID 10 in the corresponding US 2006/0135556 is a triazole. The examiner is asked to consider whether the claims should be rejected as *prima facie* obvious over WO 2004/030611. It should be noted that while Compound ID 10 of WO 2004/030611 is a tetrazole, the reference does not describe the synthesis of any tetrazole. Thus, it may be questioned whether WO 2004/030611 enables the synthesis of Compound ID 10, and whether the disclosure of Compound ID 10 can be used as the basis of a rejection under Section 103 if it is not enabling.

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Supplemental IDS

Attention is directed to the IDS (PTO/SB/08a) which is submitted herewith.

The IDS cites WO 2004/030611 which is noted above.

The IDS further cites EP 0029183 and the corresponding, English language, US 4399285.

The former was cited by the European patent office in connection with the examination of the corresponding EP 03 779 603.4 - 2101 application.

This supplemental IDS is submitted pursuant to 37 CFR 1.97(c). The fee set forth in 37 CFR 1.17(p) is provided.

Respectfully submitted,

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